

**REMARKS**

I. Status of the Claims

Claims 1-23 are pending in this application, and have been rejected.

II. Drawings

The Examiner has objected to the drawings "because of the draftsman's objections (see PTO-948)." See Office action at page 2.

Applicants submit herewith a Submission of Corrected Formal Drawings, including four sheets of formal drawings.

Accordingly, Applicants respectfully request withdrawal of the objection to the drawings.

III. Rejection Under 35 U.S.C. § 103(a)

A. Claims 1-3, 14-20, and 23

The Examiner has rejected claims 1-3, 14-20, and 23 "under 35 U.S.C. 103(a) as being unpatentable over Bessette (U.S. Patent No. 6,263,330 B1) in view of Angles (U.S. Patent No. 5,933,811)." See Office action at pages 2-5. Applicants respectfully traverse these rejections.

**Independent claim 1** is directed to a method in an interactive library system. The system must have, among other things, "a computer in telecommunication link with ... [a] *computer of at least one content provider requiring payment for information access.*" The method is for providing information from the content provider to the user, and includes receiving – by the library system computer – user identification and password from the user computer, and comparing – by the library system computer – the received user identification and password with authorized user identifications and corresponding passwords to determine whether to grant

access to the interactive library system. According to this method of claim 1, if the comparison results in grant of access, then the library system computer (1) receives input from the user computer specifying type of information desired by the user, (2) establishes telecommunication link with the content provider computer, (3) transmits the type of information desired by the user as a search request to the content provider computer, (4) receives result of the search request from the content provider computer, and (5) provides the result to the user computer.

**Independent claim 16** is directed to an “interactive library system providing telecommunication links with ... [a] *computer of at least one content provider requiring payment for information access.*” This interactive library system includes, among other things, (1) a library computer adapted to receive and transmit data over telecommunication links, the library computer having a microprocessor and a first storage unit, (2) a second storage unit electrically coupled to the library computer to store user identifications and corresponding passwords, (3) a program operable on the microprocessor stored in the first storage unit, the program comparing user identification and password received from the user computer with the user identifications and corresponding passwords stored in the second storage unit to determine whether the user computer is authorized. If the user computer is determined to be authorized, the program of claim 16 causes the library computer to communicate with the content provider computer to transmit type of information desired by the user as a search request and to receive result of said search request.

As an initial matter, Applicants respectfully note that *the Office action does not specify where the Bessette or Angles references disclose or suggest a computer or system in telecommunication link with a computer of a content provider requiring payment for information access.* For a § 103 rejection to be proper (*i.e.*, for an Examiner to meet his/her

burden of making a *prima facie* case of obviousness), the Examiner should explain why the subject matter of the claimed invention as a whole – including each limitation thereof, arranged as recited in the claim – would have been obvious to one of ordinary skill in the art at the time of the invention. In particular, the Examiner should state where each and every feature of the claim is disclosed or suggested by the cited prior art. Because the Office action does not explain where the Bessette or Angles references disclose or suggest a computer or system in telecommunication link with a computer of a content provider requiring payment for information access, Applicants respectfully submit that *the Examiner has not made a prima facie case of unpatentability* under § 103. Accordingly, Applicants ask that the rejection of claims 1-3, 14-20, and 23 under § 103 be withdrawn, and that the claims be allowed.

In addition, Applicants respectfully submit that *neither Bessette nor Angles discloses or suggests a computer or system in telecommunication link with a computer of a content provider requiring payment for information access*. Accordingly, the Examiner will not be able to make a *prima facie* case of unpatentability under § 103 in view of the cited references.

The Examiner has equated the “content provider” referenced in claim 1 with the NDSMR database of Bessette. In particular, the Examiner states that “[t]he limitation ‘receiving, by the library system computer, result of the search request from the content provider computer; and providing, by the library system computer, the result to the user computer’ is met by the server (300 in Fig. 10) [of Bessette] receiving the query result from the NDSMR database (content provider)...” See Office action at page 3. Applicants respectfully submit, however, that the NDSMR database of Bessette does not require payment for information access, and thus

does not disclose or suggest a computer or system in telecommunication link with a computer of a content provider requiring payment for information access.

The Examiner has also equated the “content provider computer” recited in claim 1 with the “content provider computer 14” in Figure 10 of Angles. Specifically, the Examiner states that “Angles shows that advertisement provider computer (18 in Fig. 10) establishes the telecommunication link with content provider computer (14 in Fig. 10).” See Office action at pages 3-4.

Applicants respectfully submit that the “content provider” of Angles does not require payment for information access. The Angles patent specifically defines the term “content provider” for use within that patent – but not necessarily in other contexts. In particular, U.S. Patent No. 5,933,811 to Angles (at column 1, lines 38-44) explains that a “content provider” within the meaning of that patent need not necessarily require payment for access to information:

A website is defined by an Internet address which has an associated electronic page, often called a “home page.” Generally, a home page is an electronic document which organizes the presentation of text, graphical images, audio and video into a desired display. These websites are operated by a wide variety of entities which are typically called “content providers.”

Indeed, Angles defines “content provider” in a manner that suggests *no payment* is required for access to information:

Information exchanged over the Internet is typically encoded in HyperText Mark-up Language (HTML) format. The HTML format is a scripting language which is used to generate the home pages for different content providers. In this setting, a content provider is an individual or company that places information (content) on the Internet so that it can be accessed by others.

See Angles at column 1, lines 56-62. In connection with one preferred embodiment disclosed in Angles, the patent explains (at column 7, lines 53-59) how a user accesses content – but does not mention that payment is required:

In operation, a consumer directs the consumer computer 12 to communicate with the content provider computer 14 via the communication medium 20. Once the consumer computer 12 establishes a communications link with the content provider computer 14, the content provider computer 14 transfers an electronic page 32 to the consumer computer 12.

In addition, Figure 3 of Angles depicts a process of a consumer requesting an electronic document. This figure (and process) is explained at column 8, lines 33-67. Nowhere in this explanation does Angles disclose or suggest that a content provider requires payment for information access.

Because neither Bessette nor Angles discloses or suggests certain features of claims 1 and 16, Applicants respectfully submit that even if these two references were combined as the Examiner has suggested (which Applicants do not concede is a proper combination), the cited prior art fails to disclose or suggest the interactive library systems recited in Applicants' claims 1 and 16.

**Dependent claims 2-3 and 14-15** depend directly or indirectly from independent claim 1, and include the features of claim 1. Because Applicants submit that the cited references fail to disclose or suggest each of the features of independent claim 1, Applicants respectfully submit that dependent claims 2-3 and 14-15 are also not obvious in view of the cited references.

In addition, at least dependent **claim 3** includes further features not disclosed or suggested by the cited references. Claim 3 additionally recites *providing a user interface, by the interactive library system to the user computer, that includes an interactive element, the*

*selection of the element by the user activating a communication program to enable communication with a pre-selected contactee.* But the Office action does not specify where in any cited reference these features of claim 3 are disclosed or suggested.

**Dependent claims 17-20 and 23** depend directly or indirectly from claim 16, and include the features of claim 16. Because Applicants submit that the cited references fail to disclose or suggest each of the features of independent claim 16, Applicants respectfully submit that dependent claims 17-20 and 23 are also not obvious in view of the cited references.

In addition, at least dependent **claims 18-20** also include further features not disclosed or suggested by the cited references. Claim 18 further includes *a third storage unit electrically coupled to the library computer to store user-specific data.* But the Office action does not specify where in any cited reference these features of claim 18 are disclosed or suggested. Claims 19-20 depend from claim 18, and are not obvious in view of the cited prior art for this additional reason.

Applicants therefore respectfully request that the rejections of claims 1-3, 14-20, and 23 under § 103(a) be withdrawn, and that the pending claims be allowed.

B. Claims 4-13 and 21-22

The Examiner has rejected claims 4-13 and 21-22 “under 35 U.S.C. 103(a) as being unpatentable over Bessette (U.S. Patent No. 6,263,330 B1) in view of Angles (U.S. Patent No. 5,933,811) and further in view of Usui (U.S. Patent No. 5,956,697).” *See* Office action at pages 5-6. Applicants respectfully traverse these rejections.

**Claims 4-13** depend directly or indirectly from claim 1, and include the features of claim 1. **Claims 21-22** depend indirectly from claim 16, and include the features of claim 16.

As noted above, Applicants submit that neither Bessette nor Angles discloses or suggests a computer or system in telecommunication link with a computer of a content provider requiring payment for information access. Applicants also respectfully submit that Usui fails to disclose or suggest these features of independent claims 1 and 16 of the present application. Accordingly, the cited references – alone or in combination – fail to disclose or suggest each and every element of claims 4-13 and 21-22. Applicants thus respectfully request that claims 4-13 and 21-22 be allowed.

In addition, dependent claims 4-13 and 21-22 recite further features not disclosed or suggested by the prior art. For example, **claim 4** additionally requires *determining – by the library system computer – time amount of access to the interactive library system by the user computer, and storing – in the library system – the time amount of access to the interactive library system by the user computer.*

The Examiner combines Usui with Bessette and Angles, and argues that “Usui teaches calculating access charges according to the amount of access time used by each client (i.e. user) – see column 3, lines 1-6.” See Office action at page 5. The Examiner then concludes that “it would have been obvious to one of ordinary skill in the art to have the library system computer receiving the search results from the content provider of Bessette and Angles and calculate access charges (i.e. account statement) according to the amount of time used by each user as taught in Usui.” *Id.* The Examiner then simply states – without providing any reasons for the statement – that “[o]ne of ordinary skill in the art would have been motivated to have the library system computer receiving the search results from the content provider and calculate access charges (i.e. account statement) according to the amount of time used by each user as

taught in Usui for charging the user for access time (see Usui, abstract).” See Office action at pages 5-6.

As the Examiner notes, Usui is directed to a timer-based fee-charging system for the Internet. In particular, Usui “relates to a way of providing access to the Internet...” such that a user can be connected without delay. See Usui at column 1, lines 5-6 and column 2, lines 24-26. Usui does not, however, disclose or suggest a computer of a *content provider* that requires payment for information access. Usui only addresses *connection* to the Internet – and is entirely silent as to whether or not content providers that may be accessible using the Internet (once an Internet connection is established) are of the type that require payment for information access.

Moreover, Applicants respectfully submit that although the Examiner has stated that one of ordinary skill would have been motivated to combine certain aspects of Usui with aspects of Bessette and Angles, the Examiner has not specified the source of such motivation.

Applicants respectfully note that an invention is not obvious unless the prior art itself suggests or teaches combination of its elements. *In re Newell*, 891 F.2d 899, 902 (Fed. Cir. 1989). Moreover, it is impermissible to engage in “hindsight reconstruction,” *i.e.*, using the recited invention as a guide, while combining teachings from separate prior art references. *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). The Federal Circuit has instructed that “the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a *showing of a teaching or motivation to combine the prior art references.*” *Ecolochem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000) (emphasis added by Applicant). Thus, in order to maintain the present rejections under § 103, Applicants



respectfully note that it is the Examiner's burden to demonstrate "a teaching or motivation to combine the prior art references" in the manner in which the Examiner has combined them.

For the foregoing reasons, Applicants respectfully request that the rejections of claims 4-13 and 21-22 under § 103(a) be withdrawn, and that the pending claims be allowed.

IV. Conclusion and Request for Reconsideration

Applicants request reconsideration of the present application in view of the aforementioned remarks. Although other features of the claims in the present application are also significant, Applicants respectfully submit that the pending claims are allowable for at least the aforementioned reasons. Accordingly, Applicants respectfully request that the rejections under § 103(a) be withdrawn, and that the pending claims be allowed.

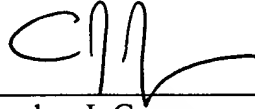
In the event that a telephone conference would advance examination of this application, the Examiner is invited to contact the undersigned at the number provided.

V. Authorization

Applicants submit herewith a check in the amount of \$420.00 and a Petition For Extension of Time requesting a two-month extension of time. Applicants respectfully submit that no further extension of time or additional fee is due. In the event that the Commissioner determines that a further extension of time or additional fee is necessary for this paper, the undersigned hereby petitions for any required extension of time, and authorizes the Commissioner to charge any fee required to Milbank's deposit account no. 13-3250, order no. 02012-40101. A DUPLICATE COPY OF THIS PAGE IS ENCLOSED HEREWITH.

Appl. No. 09/415,578  
Amdt. dated January 7, 2004  
Reply to Office action of August 7, 2003  
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Respectfully submitted,  
Milbank, Tweed, Hadley & McCloy LLP



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